UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,412	12/14/2001	Naohiro Furukawa	HITA.0132	9775

			EXAMINER
38327 7590 11/23/2004			BACKER, FIRMIN

REED SMITH LLP
3110 FAIRVIEW PARK DRIVE, SUITE 1400
FALLS CHURCH, VA 22042

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 September 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _10-22_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _10-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment

This is in response to an amendment file on September 10th, 2004. In the amendment,

claims 10-18 and 20 have been amended, claims 1-9 have been canceled, and claims 21 and 22

have been added. Claims 10-22 are pending in the letter.

Response to Arguments

1.   Applicant's arguments with respect to claims 10-22 have been considered but are moot in

view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alley et al

(U.S. PG Pub No. 20030078880) in view of Layeghi (U.S. PG Pub No. 2002/0019823).

4.   As per claim 10, 21 and 22 Alley et al teach a document processing system comprising:

input means for reading an embedding medium on a document storage mean hardcopy; and

document processing means for executing document processing base uppon information which

includes at least one document handling procedure (*see abstract, figs 2, paragraphs 0015-0018,*

0046). Alley et al fail to teach a system for extracting means for extracting document processing information embedded in the embedding medium. However, Layeghi teaches extracting means for extracting encoded document processing information embedded in the storage mean (*see paragraph 0021*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Alley et al to include Layeghi's extracting means for extracting document processing information embedded in the embedding medium because this would have provide a system of document identification that would enhance the security of document processing system.

5.   As per claim 11, Alley et al teach a document wherein the input means includes an image input means for reading a document image (*see abstract, figs 2, paragraphs 0015-0018, 0046)*.

6.   As per claim 12, Alley et al teach a document processing system wherein the document processing means executes the document handling procedure by reading character strings stated on the document in accordance with the document processing information (*see abstract, figs 2, paragraphs 0015-0018, 0046)*.

7.   As per claim 13, Alley et al teach a document processing system wherein ument is a bill for payment or a commercial paper (*see abstract, figs 2, paragraphs 0015-0018, 0046)*.

8.   As per claim 14, Alley et al teach a document processing system further comprising: an embedding medium identification means for identifying whether any embedding medium

embedded with the document processing information is on the document; and document

processing information database retrieving means for retrieving a set of document processing

information from a document processing information database of a document provider so as to

assign the set of document processing information to the document, if the embedding medium

identification means does not identify any embedding medium embedded with the document

processing information on the document (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

9.   As per claim 15, Alley et al teach a document processing system wherein said database is

stored in the document processing system or in a network to which said document processing

system is linked (*see abstract, figs 2, paragraphs 0015-0018, 0046*).

10.   As per claim 16, Alley et al teach a document processing system further comprising a

document processing information defining means for defining a new set of document processing

information to be applied to the document if the retrieving means can not retrieve any set

document processing information in the database of the document provider (*see abstract, figs 2,

paragraphs 0015-0018, 0046*).

11.   As per claim 17, Alley et al teach a document processing system wherein the set of

document processing information is selected from the database based upon a degree of similarity

between a document format associated with the set of document processing information and a

document image entered through an image input means (*see abstract, figs 2, paragraphs 0015-

0018, 0046*).

12.   As per claim 18, Alley et al teach a document processing system wherein the system

notifies the document provider the newly-defined set of document processing information so as

to be included in the database or to be embedded in other document by the document provider

(*see abstract, figs 2, paragraphs 0015-0018, 0046*).

13.   As per claim 19, Alley et al teach a document processing system comprising a document

processing charge billing means for differentiating charges billed to the document issuer

according to whether document processing information is stored on the document (*see abstract,

figs 2, paragraphs 0015-0018, 0046*).

14.   As per claim 20, Alley et al teach a document generating software product, comprising: a

communication module for enabling a prospective document user wishing to have a document

made to notify a document generator of requirements regarding a desired document layout and a

desired document handling procedure; a document layout making module for making a

document layout according to the requirements from said prospective document user; a

document candidate presenting module for presenting to the prospective document user

document candidates made by the document layout making module; a document selecting

module for letting the prospective document user select a document out of the document

candidates presented by the document candidate presenting module; and a document processing

information embedding module for enabling said document generator to embed document

processing information onto the selected document candidate itself (*see abstract, figs 2,*

paragraphs 0015-0018, 0046). Alley et al fail to teach a system document processing for reading out the selected document candidate and for printing on or embedding in the storing means of the hardcopy. However, Layeghi teaches document processing for reading out the selected document candidate and for printing on or embedding in the storing means of the hardcopy *(see paragraph 0021).* Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Alley et al to include Layeghi's document processing for reading out the selected document candidate and for printing on or embedding in the storing means of the hardcopy medium because this would have provide a system of document identification that would enhance the security of document processing system

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
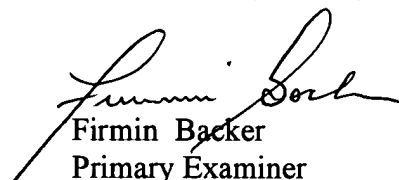
however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

November 18, 2004